



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON DC 20001

COPY MAILED

AUG 09 2004

OFFICE OF PETITIONS

| | | |
|--|---|--------------------------|
| In re Application of | : | |
| Richard Allen Hay and Brian Lawrence Smith | : | |
| Application No. 10/740,460 | : | DECISION REFUSING STATUS |
| Filed: December 22, 2003 | : | UNDER 37 C.F.R. §1.47(a) |
| Attorney Docket No.: 006393.00002 | : | |
| Title: FIELD DEPLOYABLE WIRELESS | : | |
| NETWORKING DEVICE | : | |

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed June 1, 2004.

The above-identified application was filed on October 22, 2003, identifying Richard Allen Hay and Brian Lawrence Smith as joint inventors. The application was filed with a declaration which was executed only by joint inventor Hay. On March 9, 2004, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (notice), requiring an executed oath or declaration in compliance with 37 C.F.R. §1.63 and the \$65 surcharge for its late filing. This Notice set a two-month period for reply.

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

In reply to the notice, applicant filed the instant petition, the petition fee, and the surcharge associated with the late filing of an oath or declaration.

Petitioner has also submitted a copy of the previously submitted declaration, a statement of facts, the last known address of the non-signing inventor, and copies of several letters.

Petitioner has met requirements (1) – (3) and (5) above.

Regarding the fourth requirement above, it is not clear whether a complete copy of the application was sent to the non-signing joint inventor. Paragraph 14 of the statement of facts sets forth that the Petitioner's secretary mailed only the declaration to the non-signing joint inventor on April 29, 2004. However, a copy of this letter has been provided with the instant petition, and the letter references an attached copy of the application. Hence, the statement of facts contradicts the text of the letter.

On renewed petition, Petitioner must indicate which of the above two scenarios is to be believed.

If the reference to the application in the letter of April 29, 2004 was a typographical error, Petitioner will need to either mail a complete copy of the application to the non-signing inventor and submit proof of the same, or submit a declaration which has been properly executed by each of the inventors. This action will be required as it follows that one cannot refuse to sign something which one has not been presented with, in that one may not refuse to join the application unless it is clear that the inventor understands exactly what he is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR §1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed².

Alternatively, if the failure to make reference to a complete copy of the application in the statement of facts was an inadvertent omission, no further action need be taken in regards to providing the non-signing joint inventor with a copy of the application.

For these reasons, the petition under 37 C.F.R. §1.47(a) is **DISMISSED**.

Any response to this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The renewed petition should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(a)," and should display "Please deliver to Paul Shanoski, c/o Office of Petitions" in a prominent manner.

To help assure prompt and proper attention to your response, please see Request for Alert Concerning Submitted Petitions, 1282 Official Gazette (May 18, 2004) for further information on how to assist the Office in delivering your submission to the correct location. The Petitioner may wish to consider telephoning the undersigned one month after the submission is made to confirm that the documents were properly delivered.

² In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).

Any renewed petition may be submitted by mail³, hand-delivery⁴, or facsimile⁵.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011. Please note that on approximately September 28, 2004, the Office of Petitions will relocate to the new PTO location in Alexandria. Although the mailing address will remain the same, the general phone number for the Office of Petitions which should be used for status requests will change to 571-272-3282, and the telephone number for the undersigned will change to 571-272-3225.



**Paul Shanowski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office**

³ Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

⁴ Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202.

⁵ (703) 872-9306 - please note this is a central facsimile number, and as such, there will be a delay in the delivery of the facsimile to the undersigned, which could be as much as one month.